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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92060366
Party	Defendant Intel Corporation
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Date	12/29/2014
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12 **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
13 **BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

14 FLICKINTEL, LLC, an New Mexico limited
15 liability company,

16 Petitioner,

17 v.

18 INTEL CORPORATION, a Delaware
19 corporation,

20 Registrant.

21 **MOTION AND MEMORANDUM**
22 **IN SUPPORT OF REGISTRANT’S**
23 **MOTION TO DISMISS PETITIONER’S**
24 **PETITION TO CANCEL**

25 Proceeding No. 92060366

26 Reg. No. 2585551

27 Mark: INTEL

28 Registrant Intel Corporation (“Intel”) respectfully requests dismissal of the Petition to Cancel filed by FlickIntel, LLC (“FlickIntel”). FlickIntel waived its right to challenge Reg. No. 2585551 by failing to timely file a compulsory counterclaim attacking the same registration in Opposition No. 91216159.

29 **BACKGROUND**

30 On April 30, 2014, Intel filed a Notice of Opposition in Proceeding No. 91216159 (the “pending Opposition”) opposing registration of FlickIntel’s FLICKINTEL application (Ser. No. 86025508) on the basis of over thirty of Intel’s INTEL and INTEL-formative registrations, including Registration No. 2585551. Opposition No. 91216159, Notice of Opposition [Doc. #1].

1 FlickIntel’s Answer, filed on June 9, 2014, did not allege one single affirmative defense or
2 counterclaim. Opposition No. 91216159, Answer [Doc. #2].

3 Over five months later, on November 13, 2014, FlickIntel filed the present Petition to Cancel,
4 explaining that it filed the petition “because it’s too late to counterclaim on the genericness of ‘intel’.”
5 Boyd Decl., ¶ 2. Per the Board’s April 30, 2014 Order, discovery in the Opposition closes in just seven
6 days on January 5, 2015.

7 **ARGUMENT**

8 Under Trademark Rule 2.106, “a defense attacking the validity of any one or more of the
9 registrations pleaded in the opposition shall be a compulsory counterclaim if grounds for such
10 counterclaim exist at the time when the answer is filed. If grounds for a counterclaim are known to the
11 applicant when the answer to the opposition is filed, the counterclaim shall be pleaded with or as part of
12 the answer.”¹

13 A defendant who fails to timely plead a compulsory counterclaim as provided for in the rules
14 “will thereafter be barred from seeking to cancel the registration pleaded by the opposer ... on any
15 ground that existed at the time when the answer was filed.” J. Thomas McCarthy, *McCarthy on*
16 *Trademarks and Unfair Competition* § 20:23 (4th ed. 2014) (citing *Consolidated Foods Corp. v. Big*
17 *Red, Inc.*, 231 U.S.P.Q. 744 (T.T.A.B. 1986)); *see also* TBMP § 313.04 (Where defendant fails to timely
18 plead a compulsory counterclaim, “the separate petition will be dismissed, on motion, on the ground
19 that the substance of the petition constitutes a compulsory counterclaim in another proceeding, and that
20 it was not timely asserted.”).

21 Trademark Rule 2.106 seeks “to discourage separate actions which would make for a
22 multiplicity of suits.” *Endo Laboratories, Inc. v. Fredericks*, 197 U.S.P.Q. 560 (T.T.A.B. 1977) (holding
23 that “[i]n the absence of any showing that the facts supporting applicant’s petition to cancel have only
24 recently come to applicant’s attention, ... the Board is constrained to prevent applicant from now
25 attacking opposer’s pleaded registrations.”).

26 _____
27 ¹ Allegations that a registered mark has become the generic name for the goods or services for which
28 it is registered or has been abandoned constitute defenses attacking the validity of a registration. 15
U.S.C. § 1064.

1 FlickIntel's Petition to Cancel one of the same registrations Intel asserts in the pending
2 Opposition is a compulsory counterclaim and is clearly an afterthought. FlickIntel was aware of all of
3 the alleged grounds for its attack on the validity of Registration No. 2585551 at the time of its Answer
4 in the pending Opposition. It chose to wait until over five months later to assert its counterclaims. As a
5 result of FlickIntel's inexcusable delay, a multiplicity of proceedings involving the same parties and the
6 same marks are now pending before the Board. Given that discovery in the pending Opposition closes
7 in just seven days, Intel will be substantially prejudiced by FlickIntel's delay if the Board permits
8 FlickIntel's belated Petition to Cancel to proceed.

9 Accordingly, FlickIntel's Petition for Cancellation should be dismissed on the grounds that the
10 substance of its Petition for Cancellation is a compulsory counterclaim in Opposition No. 91216159 that
11 was not timely asserted.

12 Dated: December 29, 2014

Respectfully submitted,

14 HARVEY SISKIND LLP
15 IAN K. BOYD
16 KATE W. MCKNIGHT

17 By /Ian K. Boyd/

Ian K. Boyd

18 Attorneys for Registrant,
19 Intel Corporation

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14 FLICKINTEL, LLC, an New Mexico limited
15 liability company,

16 Petitioner,

17 v.

18 INTEL CORPORATION, a Delaware
19 corporation,

20 Registrant.

21 **DECLARATION OF IAN K. BOYD IN**
22 **SUPPORT OF REGISTRANT’S**
23 **MOTION TO DISMISS**

24 Proceeding No. 92060366

25 Reg. No. 2585551

26 Mark: INTEL

27 I, Ian K. Boyd, declare as follows:

28 1. I am a member of Harvey Siskind LLP, counsel for Registrant Intel Corporation. I make this declaration freely and of my own personal knowledge. If called as a witness, I could and would competently testify to the matters set forth.

2. On November 13, 2014, I received an email from Richard Krukar, counsel for FlickIntel, LLC (“FlickIntel”). A true and correct copy of his email is attached as Exhibit A. Mr. Krukar informed me that FlickIntel filed a Petition to Cancel one of Intel’s asserted trademarks in Opposition No. 91216159 “because it’s too late to counterclaim on the genericness of ‘intel’ and this

1 way the abbreviation for intelligence, genericness of ‘intel’ and other matters are undeniably relevant in
2 at least one proceeding.” Mr. Krukar subsequently withdrew his offer to combine the proceedings.

3 I declare under penalty of perjury under the laws of the State of California that the foregoing is
4 true and correct and that this declaration was executed this 29th day of December, 2014, in San
5 Francisco, California

6 HARVEY SISKIND LLP

7
8 By /Ian K. Boyd/

9 Ian K. Boyd

10 Attorneys for Registrant,
11 Intel Corporation

1 **CERTIFICATE OF TRANSMISSION**

2 I hereby certify that a true and correct copy of the attached MOTION AND
3 MEMORANDUM IN SUPPORT OF REGISTRANT’S MOTION TO DISMISS PETITIONER’S
4 PETITION TO CANCEL and the DECLARATION OF IAN K. BOYD IN SUPPORT OF
5 REGISTRANT’S MOTION TO DISMISS (Proceeding No. 92060366) are being electronically
6 transmitted to the Trademark Trial and Appeal Board on December 29, 2014.

7
8 */Ian K. Boyd/*
9 Ian K. Boyd

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1 **CERTIFICATE OF MAILING**

2 I hereby certify that a true and correct copy of the attached MOTION AND
3 MEMORANDUM IN SUPPORT OF REGISTRANT’S MOTION TO DISMISS PETITIONER’S
4 PETITION TO CANCEL and the DECLARATION OF IAN K. BOYD IN SUPPORT OF
5 REGISTRANT’S MOTION TO DISMISS (Proceeding No. 92060366) were served on Petitioner via
6 first-class mail on December 29, 2014, postage prepaid, addressed to:

7 Richard H. Krukar
8 Ortiz & Lopez, PLLC
9 117 Bryn Mawr Drive SE
10 Albuquerque, NM 87106-2209

11 */Cynthia Lee/*
12 Cynthia Lee